



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/197,278	11/20/98	BROWN	B 563.2-6769

000490
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QM32/0710

EXAMINER

NGO, L

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 07/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/197,278

Applicant(s)
Brown et al.

Examiner
Lien Ngo

Group Art Unit
3731



☒ Responsive to communication(s) filed on 11-20-98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-37 is/are pending in the application.

Of the above, claim(s) 10-13, 15, 17, 18, 21, 22, and 34-37 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9, 14, 16, 19, 20, and 23-33 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3 and 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Applicant's election without traverse of species 1, claims 1-9, 14, 16, 19, 20 and 23-33 in Paper No. 7 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference

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inherently discloses that element or limitation. See, for example, Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

3. Claims 1-5, 8, 9, 14, 16, and 23-~~28~~²⁷ and 29-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Von Oepen (6,017,365). Von Oepen discloses, in fig. 2, a cylindrical expandable stent comprising a plurality of undulating band like elements having a first band like element 3 and a second band like band element 5, having alternating peaks and troughs, a plurality of connecting elements 7', wherein the second element having a second wavelength longer than a first wavelength of the first element and a first amplitude of the second element greater than a first amplitude of the first element.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA) 1975. However, there is no requirement that a motivation to make the modification be

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expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

5. Claims 6, 7, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Oepen. Von Oepen disclose an expandable stent substantially as claimed. Von Oepen also disclose the stent having interconnecting elements spaced three peaks apart on the second band like element and four troughs apart on the first band like element. However, Von Oepen does not disclose a stent having interconnecting elements spaced five peaks apart on the first band like element and three troughs apart on second band like element. It would have been an obvious to one having ordinary skill in the art at the time the invention was made to construct the interconnection elements as claimed above. Since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Oepen in view of Orth (5,800,521) Von Oepen discloses a stent substantially as claimed, except Von Oepen does not disclose interconnecting elements are straight. Orth teach stent having straight interconnecting elements. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Orth, to construct the stent of Oepen with straight interconnecting elements in order to connect band like elements together.

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Conclusion

7:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Ngo whose telephone number is (703) 305-0294. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, Michael Buiz, can be reached at (703)308-0871. The Group FAX number is (703) 305-3590.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.

W

Lien Ngo

July 5, 2000


MICHAEL BUIZ
SUPERVISORY PATENT EXAMINER
GROUP 3300

7/6/00